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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,223	10/08/2003	Kazuhiro Asada	117085	4047
25944	7590	12/21/2005		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER KANG, JULIANA K	
			ART UNIT 2874	PAPER NUMBER

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/680,223	Applicant(s) ASADA ET AL.	
	Examiner Juliana K. Kang	Art Unit 2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/6/05 (election).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 10-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/1/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election with traverse of Species a in the reply filed on October 6, 2005 is acknowledged. The traversal is on the ground(s) that the search and examination of the entire application could be made without serious burden to the office. This is not found persuasive because the species represent distinct inventions and thus the search and examination of the entire application causes serious burden to the Examiner; therefore, the restriction for examination purposes as indicated is proper. The Examiner also acknowledges applicant's admission of at least claims 1, 2, and 5-9 being generic to all species. Claims 4 and 10-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species. Therefore requirement is still deemed proper and is therefore made final.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5, 6 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamaguchi (U.S. Patent 6,547,446 B2).

Yamaguchi discloses an optical connector implemented and fixed to a wiring substrate (printed circuit board, see column 2 line 67, not shown) comprising: a surface-implemented type optical element (8, 9); and a first housing (combination of 10 and 34) having a housing body portion having: an element storing depression (38), which can store and hold the optical element (see column 5 lines 45-47), a guide sleeve portion (35) for guiding a fiber, and a first mounting portion (40, 30). Yamaguchi's first mounting portion that would be fixed to the wiring board by soldering is inherently will be freely adjusted in the planer direction of the wiring substrate before fixing the housing to the wiring substrate. Yamaguchi does not show a through-hole but it has to be present in Yamaguchi so that the fixing pins (30) can be soldered onto the wiring board. Yamaguchi further discloses a second housing (2) fixed to the wiring substrate wherein the second housing covers the first housing and has a lock portion (see column 3 line 33). Yamaguchi discloses that the first housing is electrically conductive (see column 5 line 58) and the second housing is made of insulative synthetic resin (see column 3 line 27).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi.

Regarding claim 7, as described above, Yamaguchi discloses the claimed invention and further teaches fixing the second housing to the wiring substrate using a fixing pin. However, Yamaguchi does not specifically teach that the second housing has a screwed portion that can be screwed and fixed to the wiring substrate. Using screws to fix or attach an element to another is well known because it provides disassembling capability. Disassembling allows easier replacement of the element. Thus it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a screwed portion in Yamaguchi to fix the second housing to the wiring substrate in order to provide disassembling capability.

Regarding claim 9, Yamaguchi does not explicitly teach that the first housing contains a material what does not melt at a processing temperature for surface implementing the optical element. Since Yamaguchi's first housing is attached to the wiring substrate using soldering it would have been obvious to one having ordinary skill in the art at the time the invention was made to recognize the use of a material which does not melt during soldering in Yamaguchi to protect the optical elements from damaging.

Conclusion

6. The prior art documents submitted by applicant have been considered and made of record (note the attached copy of form PTO-1449).

Art Unit: 2874

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chen et al (U.S. Patent 6,592,268 B2) teaches a system for mounting a connecting device to a substrate. Nagaoka et al (U.S. Patent 6,113,280) teach an optical connector. Shirakawa et al (U.S. Patent 6,499,889 B1) teach an optical connector mounted printed circuit board.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juliana K. Kang whose telephone number is (571) 272-2348. The examiner can normally be reached on Mon. & Thur. 8:00-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rod Bovernick can be reached on (571) 272-2344. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JULIANA KANG
PRIMARY EXAMINER

Juliana Kang
12/19/05